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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,668	01/22/2004	David L. Patton	80521B/F-P	5162

7590 09/15/2006
Pamela R. Crocker
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343 State Street
Rochester, NY 14650-2201

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,668

Applicant(s)

PATTON, DAVID. L.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 4-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. In view of the Appeal Brief filed on August 4, 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below for clarification purposes only.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guttag in view of Martin (5,601,683).

Guttag discloses in Fig. 1-5, philatelic item being a postage stamp (see Col. 1, lines 28+, as well as Col. 2, line 45) comprising a first visible indicia (see Col. 4, lines 3-17) which clearly is a first indicia comprising a unique ID that identifies the stamp as being one of a limited number of a predetermined number. Guttag further discloses a second indicia (stamp depiction). The Guttag stamp also inherently includes indicia which is consistent with the printer from which it was printed. It is very well known (as in the case of Denenberg et al reference) that printers are each unique and contain "flaws" or "imperfections" with the indicia printed that are unique to each printer, wherein the indicied print acts as a microscopic pseudo fingerprint (as stated in the Denenberg et al reference, Col. 3, lines 50-60 and in Col. 7, lines 36-42). This

fingerprint is analogous to that of a firearm. When a bullet is fired, a unique pattern is provided on the bullet, which identifies a single firearm. In as much set forth as to the type/structure of the indicia in the claim, such “fingerprints” are inherent to the printer which forms the stamp defining the third indicia.

However, Gutttag does not disclose; wherein the second indicia is not visible under normal viewing conditions for confirming that the limited edition stamp is a valid limited edition stamp, and is further made using an ink that can be seen when viewed under UV or infrared light.

Martin discloses in Col. 5, lines 34-43, the use of UV ink which is not viewable under normal viewing conditions (only seen with a black light) to “distinguish itself from pigment based ink”, is not capable of being scanned for reproduction (exact duplication) and is particularly used in the background of an item (see abstract) which prevents photocopying.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gutttag’s stamp with a second indicia, or indicia having additional copy preventing measures such as UV ink as taught by Martin for preventing fraudulent copies.

In regards to **Claim 1**, wherein the second indicia is not visible *for confirming that the limited edition stamp is a valid limited edition stamp*, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the second indicia of Gutttag is capable of confirming that stamp is a valid limited edition stamp.

In regards to **Claims 6**, the process wherein the second indicia is made using an ink that can be seen when viewed under UV or infrared light does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to make the second indicia using any ink as desired by the end user to achieve a desired result.

3. Claims 1, 2, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guttag in view of Martin (5,601,683).

Guttag discloses in Fig. 1-5, philatelic item being a postage stamp (see Col. 1, lines 28+, as well as Col. 2, line 45) comprising a first visible indicia (see Col. 4, lines 3-17) which clearly is a first indicia comprising a unique ID that identifies the stamp as being one of a limited number of a predetermined number. Guttag further discloses a second indicia (stamp depiction). The Guttag stamp also inherently includes indicia which is consistent with the printer from which it was printed. It is very well known (as in alternative case of the Rhoads reference) that printers are each unique and place “forensic tracer data” with the indicia printed that are unique to each printer, wherein the indicied print acts also as a microscopic fingerprint (as stated in the abstract). In as much set forth as to the type/structure of the indicia in the claim, such “tracer data” are inherent to the printer which forms the stamp defining the third indicia.

However, Guttag does not disclose; wherein the second indicia is not visible under normal viewing conditions for confirming that the limited edition stamp is a valid limited edition stamp, and is further made using an ink that can be seen when viewed under UV or infrared light.

Martin discloses in Col. 5, lines 34-43, the use of UV ink which is not viewable under normal viewing conditions (only seen with a black light) to “distinguish itself from pigment based ink”, is not capable of being scanned for reproduction (exact duplication) and is particularly used in the background of an item (see abstract) which prevents photocopying.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Guttag’s stamp with a second indicia, or indicia having additional copy preventing measures such as UV ink as taught by Martin for preventing fraudulent copies.

In regards to **Claim 1**, wherein the second indicia is not visible *for confirming that the limited edition stamp is a valid limited edition stamp*, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the second indicia of Guttag is capable of confirming that stamp is a valid limited edition stamp.

In regards to **Claims 6**, the process wherein the second indicia is made using an ink that can be seen when viewed under UV or infrared light does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior art was made by a different process (see MPEP 2113).

Therefore, it would be obvious to make the second indicia using any ink as desired by the end user to achieve a desired result.

Response to Arguments

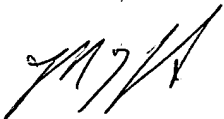
Applicant's arguments with respect to claims 1, 2, 4-6 and 8 have been considered but are moot in view of the new ground(s) of rejection. Guttag is now used to disclose a limited edition postage stamp having a first, second and third indicia. Martin is relied upon for disclosing an indicia having UV ink. The Denenberg et al, and Rhoads references inherently disclose what is already well known in the art in regards to printing coded indicia within indicia. In response to applicant's argument that the second indicia is not visible for confirming that the limited edition stamp is a valid limited edition stamp, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the second indicia of Guttag is capable of confirming that stamp is a valid limited edition stamp.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rhoads and Mackey et al disclose printing indicia within indicia to define a printer's signature.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

September 12, 2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER